

REMARKS

This is intended as a full and complete response to the Office Action dated December 8, 2010. Claims 8–15, 17–21, and 23–28 are pending. Claims 8–15, 17–21, and 23–28 stand rejected. Applicants respectfully request consideration of the following remarks in response to the Office Action.

CLAIM REJECTIONS:

Claims 8-15, 17–21, and 24-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,302,554 (*Nabeta*) in view of EP 1312624 (*Marechal*). Applicants respectfully traverse the rejection.

The Office Action acknowledges that “Nabeta does not specifically recite the use of a metallocene-catalyst ethylene polymer” and the Office Action asserts that “Marechal discloses the use of a bridged metallocene catalyst...for the production of a low density polyethylene”. With respect to motivation to combine *Nabeta* and *Marechal*, the Office Action states “it was known in the art that films comprising ethylene (co) polymers prepared using bridged metallocene catalysts are characterized by improved extrusion stability.” A previous Office Action, incorporated by reference by the Office Action, states “Marechal discloses the use of ethylene bis (4, 5, 6, 7-tetrahydro-1-indenyl) zirconium dichloride for the polymerization of a low density polyethylene (¶0037) which was found to have superior extrusion stability to other commercially available films (¶0066, Table IX) (claim 6). Applicants respectfully disagree with the Office Action’s motivation for the combination of *Nabeta* and *Marechal*.

First, the Office Action provides no evidence for the proposition that “superior extrusion stability” would be considered a motivation to combine *Marechal* with *Nabeta*. To reject a claim based on a motivation to combine rationale,

“Office personnel must articulate the following:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) a finding that there was a reasonable expectation of success; and

(3) whatever additional findings may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

MPEP §2143 G. The Office Action has implied, without any findings, that the one of ordinary skill in the art in viewing *Nabeta* would have desired greater extrusion stability. However, *Nabeta* does not indicate this as something to be desired and the Office Action has not provided any source to show that one of ordinary skill in the art would be motivated to provide greater extrusion stability.

The presence or absence of a motivation to combine references is a question of fact. *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999). The Office Action has not stated any motivation in the references themselves for the conclusion of a motivation to combine these references, nor taken official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being well-known in the art. *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970). To the extent that the Examiner is relying on official notice of facts outside the record, Applicant would respectfully state that the noticed alleged motivation is not common knowledge or well-known in the art. See 37 C.F.R. 1.111 (b), MPEP §2144.03 (C). To the extent that the Examiner is relying on common knowledge in the art or his own personal knowledge, Applicant respectfully requests that the Examiner provide the appropriate documentary evidence, affidavit or declaration. 37 CFR §§ 104(c)(2), 1.104 (d)(2). For these reasons, Applicant asserts that Office Action's rejection based on the stated motivation to combine is improper.

Further, the motivation cited by the Office Action is improper as being outside that allowed. As stated in *In re Kahn*, cited by MPEP §2144.01 in support of when a motivation to combine rationale different from the applicant's is permissible:

Therefore, the "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, *and motivated by the general problem facing the inventor*, would have been led to make the combination recited in the claims.

In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006). The problem facing the Applicants in this case is stated in the Application (Page 3, lines 4 – 9):

The main object of the present invention is to produce films from compositions of mPE and styrene-butadiene block copolymers that are

well sealed onto containers made of polypropylene or polystyrene resins while being peelable.

It would be advantageous if in addition these films would achieve good organoleptic and optical properties.

Thus, according to *In re Kahn*, one of ordinary skill in the art must be motivated by the same general problem facing the inventor – in this case, peelable, well-sealed films with good organoleptic and optical properties. Good extrusion stability was not “the same general problem facing the inventor.”

In addition, as stated in the Appeal Brief by Applicants, the use of a metallocene catalyst to produce the resin in the present Application as recited by Claim 8 provides unexpected advantages over a Ziegler-Natta produced resin. The Office Action states that:

The examiner first notes that applicant alleges that the olefinic polymer of Nabeta is a Ziegler-Natta catalyzed polymer; however, there is no evidence currently on record to substantiate this allegation. Nabeta does not state that the olefinic polymer is made using a Ziegler-Natta catalyst; rather, Nabeta is silent regarding the type of catalyst used to prepare the olefinic polymer. Regarding test run 35 cited in the rejection of claims, Nabeta only discloses that the olefinic polymer is the commercially available polymer TAFMER-A 4085. There is no evidence on record that demonstrates that this commercial copolymer is prepared using a Ziegler Natta catalyst.

Attached to this Office Action Response are two documents: A Mitsui Petrochemical Industries, LTD. report on Tafmer A Resins, which describe them as Ziegler catalysts (1st page, 1st paragraph) ; and U.S. Patent No. 4,707,512 (Col. 3, lines 42 – 65) which describes Tafmer A-4085 as a resin produced from a Ziegler Natta catalyst. Thus, the Office Action’s rejection for lack of unexpected advantages (“the lack of evidence demonstrating that the prior art uses Ziegler-Natta catalysts to prepare the olefinic polymer) is moot. For these reasons, the Applicants respectfully request that the rejection to Claims 8-15 17–21, and 24-27 under 35 U.S.C. §103(a) as being unpatentable over *Nabeta* in view of *Marechal* be withdrawn.

Claims 8-11, 13, 14, 17, 18 and 24-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,022,612 (*Wilkie*) in view of K RESIN[®] DK11 Product Data Sheet. Claims 12 and 15 stand rejected under 35 U.S.C. §103(a) as being

unpatentable over *Wilkie* in view of K RESIN[®] DK11 Product Data Sheet and EP 1312624 (*Marechal*). Applicants respectfully traverse the rejections.

The Office Action provides no evidence that the *Wilkie* discloses a *peelable* film as recited by the claims of the present Application. The prior Office Action incorporated by reference in the present Office Action states:

Wilkie discloses packaging films which comprise a polymeric layer made from a blend of a polyolefin and a thermoplastic rubber, particularly a blend of polyolefin and either a styrene/isoprene/styrene block copolymer or a styrene/butadiene/styrene block copolymer (abstract).

Applicants disagree to the extent that this description is incomplete. *Wilkie* teaches multi-layer film; the cold seal skin layer, referenced by the Office Action, is a blend of “between about 5% and about 95% by weight thermoplastic rubber and between about 5% and about 95% by weight polyolefin” and a core layer of “one or more polymer selected from isotactic homopolymer polypropylene, syndiotactic homopolymer polypropylene, ethylene-propylene random copolymer, ethylene-propylene block copolymer, polybutylene homo- and copolymers, polyethylenes, ethylene-propylene-butylene terpolymers, and plastomers made by metallocene catalysis of ethylene and at least one member selected from the group consisting of pentene, hexene, heptene, octene, nonene and decene.” The Office Action provides no teaching in *Wilkie* that would indicate that such a multi-layer film would be peelable as required by the claims of the present Application. Neither *Wilkie* nor the K RESIN[®] DK11 Product Data Sheet teach the removal of the core layer of *Wilkie*.

In addition, the prior Office Action incorporated by reference in the present Office Action states that “*Wilkie* does not teach the use of a styrene/butadiene block copolymer wherein the amounts of styrene and butadiene fall within the claimed range,” but by modifying *Wilkie* to the composition found in the K RESIN[®] DK11 Product Data Sheet” would “simplify the production of the composition by eliminating the need to synthesize the thermoplastic rubber and take advantage of the commercial polymer’s properties of high light transmittance.”

Applicants disagree for two reasons. First, the Office Action provides no evidence that combining *Wilkie* with the composition found in the K RESIN[®] DK11 Product Data Sheet would “simplify the production of the composition by eliminating the

need to synthesize the thermoplastic rubber and take advantage of the commercial polymer's properties of high light transmittance." To the extent that the Examiner is relying on official notice of facts outside the record, Applicant would respectfully state that the noticed alleged motivation is not common knowledge or well-known in the art. *See* 37 C.F.R. 1.111 (b), MPEP §2144.03 (C). To the extent that the Examiner is relying on common knowledge in the art or his own personal knowledge, Applicant respectfully requests that the Examiner provide the appropriate documentary evidence, affidavit or declaration. 37 CFR §§ 104(c)(2), 1.104 (d)(2).

Second, it is well established that if a proposal for modifying the prior art in an effort to attain the claimed invention causes the art to become inoperable or destroys its intended function, then the requisite motivation to make the modification would not have existed. *See, In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992), *In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959) (holding the suggested combination of references improper because it "would require a substantial reconstruction and redesign of the elements shown in [a prior art reference] as well as a change in the basic principles under which [that reference's] construction was designed to operate"). The Office Action states that Applicants have not "demonstrated that the proposed modification destroys the primary reference's intended purpose" because "Wilkie expressly envisions the production of films that have improved cold seal receptivity only; a matte finish is not required." The Office Action has provided no evidence that the composition found in the K RESIN[®] DK11 Product Data Sheet would function as a cold seal skin layer. To the extent that the Examiner is relying on official notice of facts outside the record, Applicant would respectfully state that the noticed alleged motivation is not common knowledge or well-known in the art. *See* 37 C.F.R. 1.111 (b), MPEP §2144.03 (C). To the extent that the Examiner is relying on common knowledge in the art or his own personal knowledge, Applicant respectfully requests that the Examiner provide the appropriate documentary evidence, affidavit or declaration. 37 CFR §§ 104(c)(2), 1.104 (d)(2).

For these reasons, and the reasons above with respect to *Marechal*, Applicants respectfully request withdrawal of the rejections.

Claims 8 – 15, 17 – 19, 24, 25 and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 01/15897 (*Ishii*) in view of *Marachel*. Applicants respectfully traverse the rejection.

Ishii teaches the following film (Page 3, lines 11 – 25):

The present invention provides a heat-sealing film having a haze of not more than 30% and having a sealant layer made of a resin composition which comprises from 50 to 100 wt% of the total of the following components (a) to (c) :

- (a) from 5 to 50 wt% of a block copolymer of from 50 to 95 wt% of a styrene-type hydrocarbon and from 5 to 50 wt% of a conjugated diene-type hydrocarbon,
- (b) from 5 to 50 wt% of an ethylene/ α -olefin random copolymer, and
- (c) from 5 to 70 wt% of a block copolymer of from 10 to 50 wt% of a styrene-type hydrocarbon and from 50 to 90 wt% of a conjugated diene-type hydrocarbon, and
- (d) from 0 to 50 wt% of an impact-resistant polystyrene.

Ishii teaches the following about the following about the ranges of composition of these three components (Page 5, lines 1 – 15):

If component (a) is less than 5 wt%, film-forming tends to be difficult, and if it exceeds 50 wt%, the temperature dependency of the peel strength tends to be remarkable, and the readily openable property tends to be impaired.

If component (b) is less than 5 wt%, no adequate peel strength tends to be obtained, and if it exceeds 50 wt%, adhesion to rolls during film-formation tends to increase, whereby the film-forming tends to be difficult.

If component (c) is less than 5 wt% , it tends to be difficult to obtain a sealing condition required to impart the readily openable property, and if it exceeds 70 wt%, film-forming tends to be difficult.

If component (d) exceeds 50 wt%, the transparency tends to be hardly obtainable.

It appears from Applicants' reading of the Office Action, that the Office Action is equating component (a) of *Ishii* with the styrene-butadiene block copolymer of Applicants' claims and component (b) of *Ishii* with the metallocene catalyzed ethylene polymer of Applicants' claims. However, Applicants' claims recite "wherein either the

metallocene catalyzed ethylene polymer or the styrene-butadiene block copolymer are present in the composition in an amount of greater than 50 wt.%. ” *Ishii* teaches against this requirement.

“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP § 2141.02 citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP § 2143.01 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As shown above, *Ishii* teaches that *neither* the ethylene polymer nor the styrene-butadiene block copolymer should exceed 50%, as is specifically required by Applicants’ claims. The Office Action proposes rendering *Ishii* unsatisfactory for its intended purpose. For this reason, and for the reasons cited above with respect to *Marachel* in combination with *Nabeta*, Applicants request withdrawal of this rejection.

CONCLUSION

For at least the foregoing reasons, Applicants contend that the claims are not obvious over the cited art. In view of the foregoing remarks and for various other reasons readily apparent, Applicant respectfully requests reconsideration of the pending claims and submit that all of the claims now present are allowable, and withdrawal of the rejections and a Notice of Allowance are courteously solicited.

If any impediment to the allowance of the claims remains after consideration of this amendment, a telephone interview with the Examiner is hereby requested by the undersigned at (713) 752-4329 so that such issues may be resolved as expeditiously as possible.

No additional fees are believed to be due at this time. The Commissioner is hereby authorized to charge any fee that has been overlooked or to credit any refund to Deposit Account No. 10-0096.

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